

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Chris Mesa et al.

ATTORNEY DOCKET NO: 10017722-1

SERIAL NO.: 09/944,659

GROUP ART UNIT: 2179

FILED: August 31, 2001

EXAMINER: T. Chuong

TITLE: Scanning To At Least One Of Multiple Destinations

REPLY BRIEF (FOR THE THIRD APPEAL)

Claims 25-27 and 30-31 stand rejected under Section 102(a) as being anticipated by Monty (5799070). The Examiner advances a new position in the Answer, arguing a user "could have" selected a destination fax server using a conventional fax machine like that disclosed in Monty and that the selected fax server "is configured automatically to select recipient/resource of the document...." Answer page 7.

The Examiner is obligated to show that Monty supports the factual premise on which the new argument is based. To establish a prima facie case of anticipation based on Monty, the Examiner must show that Monty describes, either expressly or inherently, each and every element of the claim. MPEP 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The Examiner has made no showing whatsoever that Monty supports the new factual premise. The Examiner has, therefore, failed to establish a prima facie case of anticipation based on Monty.

In fact, Monty does not support the new factual premise. Monty does not teach that "a user could have selected a destination fax server." So far as Applicants can tell, Monty says nothing at all about a destination fax server in general and specifically not a fax server "configured automatically to select recipient/resource of the document...." Monty teaches a sending machine dialing a telephone number to reach a destination machine. Monty does not teach that the destination machine is or may be a so-called "fax server" or that any such fax server, upon receiving data from

Monty's sending machine, is somehow able to determine an intended recipient/resource. If the Examiner is suggesting that such a fax server exists in the prior art, and that it might be obvious to combine the fax server with Monty, then he is respectfully requested to cite the art and make his case, bearing in mind of course that he still must show displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral.

Claim 25 recites "displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral." Claim 27 recites "displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral ... and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral." As detailed in the Appeal Brief, Monty does not teach displaying any such user interface. Conspicuously absent even from the Examiner's new, unsupported factual assertions is any mention of a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral.

This Application has undergone an extraordinarily long prosecution that now includes three appeals and a seemingly unending string of Actions and Responses. Yet, the Examiner still has not been able to cite to any prior art that teaches or even suggests the claimed two tiered destination selection scheme -- (1) displaying a user interface from which one or more of multiple destination devices and a resource on one or more of the devices may be selected to receive data from an input peripheral and (2) the input peripheral transmitting data representing the document to the resource on the selected destination device(s). Applicants respectfully submit that the time has come at long last to allow those claims that are the subject of this appeal.

Respectfully submitted,

/Steven R. Ormiston/

Steven R. Ormiston
Reg. No. 35,974
(208) 433-1991 x204